

REMARKS**Amendments to the claims**

Claim 22 is added. Claim 22 is dependent on claim 1, is directed to features of the drill string recited in claim 1, and includes features similar to those recited in claim 15. No new subject matter is believed to have been added by way of this amendment.

Restriction

The Examiner has requested a restriction of the claims under 35 U.S.C. § 121 to one of three allegedly distinct inventions, namely:

- I. Claims 1-8 and 18-21 to a raise bore drilling and lining apparatus;
- II. Claims 9-14 to a reamer assembly for use with a raise bore drilling and lining apparatus; and
- III. Claims 15-17 to a drill rod.

Applicant elects the restriction of the claims to invention I with **traverse**.

According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions, namely (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the Examiner if restriction is required.

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it may include independent or distinct claims.

In the present application, an Office Action was mailed on August 17, 2005, in which all

of the above-noted claims were examined including a search of the prior art for each claim. In fact, claims 18-21 were deemed to be allowed and claims 2-8 and 10-14 deemed to be allowable if rewritten in independent form. Clearly the Examiner did not consider there to be a serious burden at that time since no restriction requirement was raised in that Office Action.

Applicant respectfully submits that the requirement for restriction of the claims is improper as the subject matter for all pending claims has already been searched and an examination based on the merits of those claims has already been conducted. Therefore, Applicant believes that criterion (B) cannot be considered to have been met.

Notwithstanding the above, Applicant respectfully submits that the claims belong in the same application for reasons set forth below.

The Examiner believes that inventions I and II are related as combination and subcombination and has stated that "...the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination does not include limitations directed toward the enlargement of an existing bore. The subcombination has separate utility such as perforated casing cleaner." Applicant respectfully disagrees.

Independent claim 1 is directed to a raise bore drilling and lining apparatus for creation of a borehole. Independent claim 9 is directed to a reamer assembly for use with a raise bore drilling and lining apparatus. Clearly the reamer assembly of claim 9 can only be reasonably practiced with an apparatus such as that recited in claim 1. In fact, claim 9 specifically recites this in the preamble. It is unclear how the Examiner has determined that the reamer assembly of claim 9 has separate utility such as for a perforated casing cleaner when clearly claim 9 is directed to a reamer assembly and the liner material is distributed during operation of the reamer assembly. Clearly a reamer assembly for use with a raise bore drilling and lining apparatus would only be reasonably practiced with a raise bore drilling and lining apparatus such as that recited in claim 1.

Applicant respectfully submits that the Examiner's requirement for separating inventions

I and II is improper and, Applicant believes that inventions I and II are not distinct, are directed to the same invention, and thus should be included in the same application.

The Examiner believes that inventions I and III are also related as combination subcombination and has stated that "...the combination as claimed does not require the particulars of the subcombination as claimed because the specifics of the fluid delivery system of the subcombination is not required to supply liner material of the combination requiring simply a conduit within or along a drill string."

Claim 1 requires a material supply connected to the spreader assembly to supply the liner material to the spreader assembly. Claims 6-8 characterize the apparatus as including ducts for carrying fluid through the drill string for driving a motor and supplying liner material. Claim 15, recites a drill rod suitable for supplying such fluids. Clearly, the presence of claim 6-8 would require a search of the prior art that includes a particular drill rod for conveying fluid to the spreader assembly and motor. In fact, the Examiner's original search presumably covered such a combination since a restriction was not required in the above-noted Office Action.

Notwithstanding the fact that the subject matter of claim 15 should be included in the same search that would cover claims 6-8, Applicant has included new claim 22 that characterizes the drill string and material supply recited in claim 1 as including the features recited in claim 15. Therefore, a further search by the Examiner would require a search of both an apparatus as recited in claim 1 and such an apparatus including a drill string as recited in claim 15.

Accordingly, Applicant believes that inventions I and III should be allowed in the same application.

The Examiner believes that inventions II and III have "...separate utility such as stated above." Applicant believes that the above has shown that inventions I and II should be included in the same application, as well as inventions I and III and, as such, inventions II and III should thus also be included in the same application for at least that reason.

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In view of the foregoing, although Applicant has provisionally elected invention I with traverse under 37 CFR 1.143, Applicant respectfully requests that the Examiner reverse his restriction requirement and continue examination of claims 1-22 as a single invention.

Applicant requests early reconsideration and allowance of the present application.

Respectfully submitted,



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